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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,113

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Christopher J. Cookson

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EXAMINER

DINH, TAN X

ART UNIT

PAPER NUMBER

2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/716,113

Applicant(s)

COOKSON ET AL.

Examiner

TAN X. DINH

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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1) The I.D.S filed 1/30/2004 and 8/01/2005 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

2) The disclosure is objected to because of the following informalities:

The related applications in the specification must include the serial numbers and the filing dates of those applications.

Appropriate correction is required.

3) The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "one side is provided with at least two data layers on one side and providing data in tracks on one side" (*claim 23*), "the data layer on first side includes a main portion with data track and another area with disc characteristic information" (*claim 26*), "another area includes rotation indicia defining a direction of rotation for the disc that allows data to be read" (*claims 27 and 29*) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

DOUBLE SIDE OPTICAL DISC HAVING SPIRAL TRACKS OF DIFFERENT DIRECTIONS.

5) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6) Claims 1-25 *and* 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/718,084. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-14 of copending Application No. 10/718,084 recite all the features as claimed in claims 1-25 *and* 28 of this instant application with slightly different in languages. However, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7) Claims 26,27 *and* 29 are rejected under 35 U.S.C. 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 26,27 *and* 29 recite the features of " the data layer on

first side includes a main portion with data track and another area with disc characteristic information " (*claim 26*), " another area includes rotation indicia defining a direction of rotation for the disc that allows data to be read " (*claims 27 and 29*) which were not described in the specification. Therefore, someone of ordinary skill in the art cannot practice the invention.

8) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

9) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10) Claims 1-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by ITO et al ( 5,881,032 ).

ITO et al discloses an optical disc as claimed in claim 1, comprising:

a first side and a second side, each side including a first data layer and a second data layer ( Figs.1A and 1B, data layers L1 and L2, figures 13A,13B and 13D, data layers L1 and L2 );

wherein data are arranged on the data layers of first side along first spirals oriented in a first direction when viewed on first side, and data are arranged on the data layers of second side

along second spirals oriented in a direction opposite that of first spirals when viewed on second side ( Figs.1A and 1B, the spiral tracks on each side are opposite directions when view on each side, figures 13A and 13B, the spiral tracks on each side are opposite directions when view on each side ).

As to claim 2, ITO et al shows the double sides optical disc has a periphery and a hub, and wherein data are contained on tracks having spiral orientations between periphery and hub ( figures 1A, 1B, 13A and 13B, the hub is located at the center of the disc ).

As to claim 3, ITO et al shows the double sides optical disc has lead-in area and lead-out area ( Fig.1D, lead-in area 1a and lead-out area 1b ).

As to claim 4, ITO et al shows wherein data are arranged on the disc to be played in sequence starting with data on first side and ending with data on second side ( Fig.1D, reproduction direction ).

Claim 5 is rejected with the same reasons set forth in claim 1 above.

As to claim 6, ITO et al shows the double sides optical disc has bottom layer having bottom track extending between the hub and peripheral of the disc ( figures 1A,1B,1D,13A,13B and 13D, the hub is located at the center of the disc ).

As to claims 7-11, ITO et al shows the data are arranged from



one layer and ending at the other layer ( Figs. 1D and 13D ).

As to claim 12, ITO et al shows the first track of the sequence starts from the periphery and extends toward the hub and the last track of the sequence starts from the hub and extends toward the periphery ( Fig.2, L2 and L3 ).

As to claim 13, ITO et al shows the sequence starts at the periphery of the disc and ends at the periphery of the disc ( Fig.2, L2 and L3 ).

As to claim 14, ITO et al shows the sequence starts at the hub and ends at the hub of the optical disc ( Fig.1D, reproduction direction ).

As to claim 15, ITO et al shows the layers on each side has spiral track in opposite direction ( figures 1A, 1B, 13A and 13B have the spiral tracks in opposite directions ).

Claim 16 is rejected with the same reasons set forth in claim 1 above.

Claim 17 is rejected with the same reasons set forth in claim 2 above.

Claim 18 is rejected with the same reasons set forth in claim 3 above.

Claim 19 is rejected with the same reasons set forth in claim 4 above.

Method claim(s) 20 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore, method claim 20 is rejected for the same reasons of anticipation (obviousness) as used above.

Claim 21 is rejected with the same reasons set forth in claim 17 above.

Claim 22 is rejected with the same reasons set forth in claim 19 above.

As to claim 23, ITO et al shows one side is provided with at least two data layers on one side and providing data in tracks on one side ( Fig.2, L1, L2, L3 and L4 ).

Claim 24 is rejected with the same reasons set forth in claim 1 above.

As to claim 25, ITO et al shows data track includes program data ( Fig.1D, reproduction ).

As to claim 28, ITO et al shows data track is blank so that it can accept data ( Fig.1D, the data layers L1 and L2 are blank before recording information data ).

11) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13) Claims 26,27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over ITO et al ( 5,881,032 ).

ITO et al discloses all the subject matter as claimed in claims 26,27 and 29, except to specifically show an indicia for defining a direction of rotation of the optical disc. However, the indicia for defining a direction of rotation is inherently in every optical disc with spiral track since without this feature the optical disc cannot be correctly rotated during reproducing process. Therefore, one of ordinary skill in the art at the time of the invention was made

would have been motivated to use an indicia in ITO et al's double side optical disc for defining the rotation of the medium as claimed.

14) Claims 1,2,3,5,16-18,20,21,24,25 and 28 are further rejected under 35 U.S.C. 102(b) as being anticipated by O'HARA et al ( 5,418,774 ).

O'HARA et al discloses an optical disc as claimed in claim 1, comprising:

a first side and a second side, each side including a first data layer and a second data layer ( Fig.3, recording layers A and B on both sides );

wherein data are arranged on the data layers of first side along first spirals oriented in a first direction when viewed on first side, and data are arranged on the data layers of second side along second spirals oriented in a direction opposite that of first spirals when viewed on second side ( figures 4a,4b,5a and 5b. See also column 7, line 52 to column 8, line 24 ).

As to claims 2 and 3, the features of optical disc includes lead-in area, lead-out area, a periphery and a hub and wherein data are contained on tracks having spiral orientations between periphery and hub is inherent in every optical recording disc.

Claims 5,16 and 24 are rejected with the same reasons set forth in claim 1 above.

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Method claim(s) 20 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore, method claim 20 is rejected for the same reasons of anticipation (obviousness) as used above.

Claims 17 and 18 are rejected with the same reasons set forth in claims 2 and 3 above.

As to claim 21, O'HARA et al shows forming tracks in radial direction between periphery and hub ( figures 4a, 4b, 5a and 5b. The hub is center of the spiral track ).

As to claim 25, O'HARA et al shows data track includes program data ( Fig.1a, the data on the track is reproduced ).

As to claim 28, O'HARA et al shows data track is blank for recording information data ( the double sides optical disc original is blank for storing information data into spiral track ).

15) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

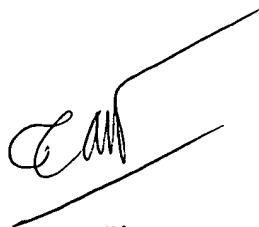
Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

16) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

The FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH  
PRIMARY EXAMINER

December 28, 2006